

Appl. No.: 09/809,584
Amndt. dated December 30, 2006
Reply to Final Office Action of September 22, 2005

REMARKS

Claim Status

Claims 1-27 remain pending.

Rejections Under 35 USC § 103(a)

Claims 1-27 stand rejected under 35 USC § 103(a) as obvious in view of http://web.archive.org/web/*/http://www.datek.com 1996 & 1997 ("Datek") in view of Mutual Fund Newsletter, Volume 1, April 1, 2000 ("Newsletter"). Claims 16-27 stand rejected under 35 USC § 103(a) as unpatentable over Datek in view of U.S. Patent No. 6,226,655 ("Barman"). Applicants respectfully traverse these rejections and request reconsideration.

The Patent Laws specify that a patent applicant is entitled to a patent unless the Examiner can carry his burden to show that the applicant is not entitled to the patent. 35 USC § 102 ("A person shall be entitled to a patent unless: ..."). In the case of 35 USC § 103, this means that the Examiner must make a *prima facie* showing of obviousness for each and every claim. The Applicant submits that the Examiner's rejection lacks adequate specificity to constitute such a showing, and therefore the Examiner's burden under 35 USC § 103 has not been carried. MPEP § 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness"). Although the Examiner has applied both the Datek and Newsletter references against the claims, in the initial office action only each of the entire documents was cited and in the final office action only a portion of the claims were addressed. Furthermore, the Examiner has provided no motivation to combine the applied art. MPEP §§ 2143.01, 2142 ("The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.")

A general review of the invention may be helpful to the Examiner, as there is crucial claim language the Examiner has appeared to overlook. The invention is generally directed toward a method and system for simplifying the submission process for a person trading financial instruments such as securities or options. As disclosed in the Background of the Invention, prior to the invention trading order placement would benefit from increased efficiency because of the large amount of data each trade requires to be input. The Abstract of the

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Invention explains that a third party computer responds to investment information requests from an investor computer by providing HTML documents having the desired investment information and a link. The link includes an indicator of a specific security associated with the investment information. When the third party computer is an investment research service, the order form is pre-filled, greatly expediting the investor's ordering process.

The office action of September 22, 2005 was indicated as being final. This limits the options available to the Applicant. The Applicant believes that each of the pending claims is allowable and therefore requests allowance of all the claims. A minimum, however, the Applicant respectfully requests the Examiner to identify with more specificity the passages relied upon in the applied art, and that each limitation of the claims discussed below be addressed. This will allow the Applicant to respond to the Examiner's rejections more clearly.

The Applicant respectfully submits that the Examiner has not responded to critical limitations included in the claims and pointed out to him in the Applicant's previous response. Furthermore, even insofar as the Examiner responded to the Applicant's arguments, the Examiner fails to consistently apply the proper standard for determining obviousness. Moreover, the Examiner has provided no motivation to combine the applied art.

The application includes two independent claims.

Claim 1:

Claim 1 (in shorthand) recites retrieving from a service provider information regarding a specific security, including a link to an online brokerage service, actuating the link, thereby retrieving an order form for the specific security from the online brokerage service, completing the order form, and submitting the order form to the brokerage service.

As stated in Applicant's last response on page 4, nowhere "does the cited art offer any teaching or suggestion of security-specific information that includes a representation of a link to an online brokerage service."

In the Final Office Action of September 22, 2005, the Examiner responds to these alleged deficiencies in the applied prior art,

Re. Applicant's argument (Ref. claim 1) "retrieving from a service provider ... " datek disclose this in pages 13-14 "What You Can Trade with Datek Online". It is obvious that in order to trade buy/sell a security, it is for specific security (see

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web page 13 "\$50.00 for us to send you a stock certificate), which indicates that there is a specific stock (security) traded.

Further HTML and URL are well known to one skilled in the art, where the URL of any site can be embedded in the HTML page to allow user to access a web site without typing or knowing the address of the web page (see page 12/23 of Datek, where a URL is embedded in the web page. For example, see <http://.../orders4.datek.com> or Visitor's Center icon, etc.) There is no sanction that a URL for a brokerage firm or a company cannot be embedded in WebPages. For example, webpage for USA Today (9/14/05) <http://www.usatoday.com/money/front.htm> has link to Scottrade brokerage firm, this is well known and it has been used in past to surf different sites (web-pages).

OA of 9/22/05, pp.7-8.

The Examiner's response does not, however, address the entirety of the language of claim 1 cited by the Applicant. It is the Applicant's right to define the metes and bounds of his invention, not the Examiner's, and the Examiner must address each and every limitation in the claim as it is written. MPEP § 2143.03 ("All Claim Limitations Must Be Taught or Suggested"). The claims may not be re-written by the Examiner simply because the recited subject matter is not suggested by the prior art.

Claim 1, as it is written, recites in part "retrieving from a service provider information regarding a specific security, wherein the information includes a representation of a link to an online brokerage service..."

This step of claim 1 includes two portions:

- (1) retrieving information;
- (2) the information including a link to an online brokerage service.

The Examiner states, as quoted above, that "the URL of any site can be embedded in the HTML page..." (emphasis supplied). This is an improper standard to determine obviousness. MPEP § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.") (emphasis in original). Using a standard of what can be done in the prior art is tantamount to applying an "obvious to try" standard for patentability. This has been specifically forbidden by the Court of Appeals for the Federal Circuit as a standard for obviousness. MPEP

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2145; *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) ("The admonition that 'obvious to try' is not the standard under § 103 has been directed at two kinds of errors ... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.") This is not merely an intellectual distinction, as claim 1 has specific requirements not easily answered by a general citation to a reference, or a statement that something can be done. For example, where specifically does the applied art suggest a link be provided to the user in light of the fact that (according to the requirements of claim 1) information was already being accessed? In other words, why should a representation for a link be part of the information that is being retrieved? Assuming that a link would be provided, where does the prior art suggest a link to an online brokerage service as contrasted to any other link? These answers remain unanswered both by the applied art and by the Examiner. Claim 1 then requires the link to the online brokerage be used to obtain an order form for a specific security, another requirement wholly absent from that applied prior art.

The art cited by the Examiner represents no more than what the Applicant admitted as prior art – that online brokerages and weblinks existed prior to the invention. It is their combination, with the other subject matter recited in the claim such as a service provider and in the manner recited in the claim, that the Applicant considers patentable.

Allowance of claim 1 is respectfully requested.

Claim 16:

Claim 16 recites, in shorthand, a system with three computers: an investor computer, a brokerage computer, and a third party computer, each coupled to the network. The third party computer is configured to respond to investment information requests from the investor computer by providing HTML documents having the investment information and a representation of a link, where the link is a URL address of order software on the brokerage computer, and where the link includes an indicator of a specific security associated with the investment information.

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As stated in the Applicant's last response at pages 4-5, Applicants are unable to find any teaching or suggestion of a URL for order software, any such URL in an HTML document with investment information, or any such document being provided by a third party computer.

In the Final Office Action of September 22, 2005, the Examiner responds to these alleged deficiencies in the applied prior art,

Re. Applicant's argument (Ref. claim 16) "a third party computer ...URL ...on brokerage computer." Prior art Datek, discloses URL links (see web page 3/23 of prior art Datek previously submitted) where the icons "New Accounts" is linked to web page 4/23 (see URL for each web page is printed at lower part of the page. For example, page 12/23, in 1997 the Datek URL <https://orders4.datek.com> would had provided a webpage to order a security, since now it is archived (<http://web.archive.org/web/19970605010656/https://orders4.datek.com>) it does not work. Similarly, http://web.archive.org/web/.../www.datek.com/applications/index_s.html URL for web page 4/23 is <http://web.archive.org/web/19970605010656> by clicking on this URL or copying this URL on Internet explorer address box, a person can get to this web page. Also see page 12/23 "Tip Archive" and "Just go to the account Options link ..." which indicated links between the two WebPages and these WebPages may be for different sites.

Further HTML and URL are well known to on skill in the art, where the URL of any site can be embedded in the HTML page to allow user to access a web site without typing or knowing the address of the web page (see page 12/23 of Datek, where a URLs are embedded in the web page. For example, see <http://.../orders4.datek.com> or Visitor's Center icon, etc.) There is no sanction that a URL for a brokerage firm or a company cannot be embedded in WebPages. For example, webpage for USA To Day (9/14/05) <http://www.usatoday.com/money/front.htm> has link to Scottrade brokerage firm, this is well known and it has been used in past to surf different sites (web-pages).

OA of 9/22/05, pp.7-8.

With regard to the Examiner's contention that datek contains URL addresses, the Applicants caution that claim 16 does not simply recite a URL address in isolation, or directed to a separate computer. As the Examiner points out, use of a URL was known prior to the invention and this fact is readily admitted by the Applicant. What is not known, however, is to configure a system in the manner of claim 16, which requires, in part,

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- (1) a third party computer to respond to investment information requests
- (2) from the investor computer by
- (3) providing HTML (hyper-text markup language) documents having the investment information and
- (4) a representation of a link, where the link is a URL (uniform resource locator) address of
- (5) order software
- (6) on the brokerage computer, and
- (7) where the link includes an indicator of a specific security associated with the investment information.

Each of these limitations is contained in claim 16. None of them would be ignored by a Court, and similarly, none of them may be ignored by the Examiner when making his rejection. MPEP § 2143.03 ("All Claim Limitations Must Be Taught or Suggested"). The Examiner is requested to provide the basis of his rejection for each and every one of these limitations. MPEP § 2141.02 ("II. Distilling the Invention Down to a 'Gist' or 'Thrust' of an Invention Disregards 'As a Whole' Requirement"). Simply put, none of Datek, Newsletter, or any combination thereof teaches or suggests all these claim limitations.

Allowance of claim 16 is respectfully requested.

The Examiner has also failed to provide a motivation to combine the datek and Newsletter references. The Applicants respectfully suggests the Examiner explain how these references would be combined in the manner suggested by the Examiner. Because a combination of datek and Newsletter would not suggest the inventions recited in the claims, allowance of each of the claims is respectfully requested.

Conclusion

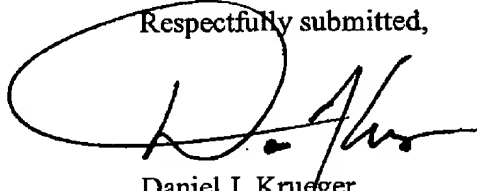
In the course of the foregoing discussions, applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood

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that there are other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769/1991-00200/HDJK.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Krugger', is written over a large, hand-drawn oval. The signature is fluid and cursive.

Daniel J. Krugger
Reg. No. 42,771
Attorney for Applicants
Conley, Rose, P.C.
P.O. Box 3267
Houston, Texas 77253-3267
Ph: (713) 238-8000